

## **REMARKS/ARGUMENTS**

Claim 1 has been amended to further define over Moorehead. No new matter has been added by this amendment. Reconsideration of this Application and entry of this Amendment are respectfully requested. The proposed amendment places the claims in better form for appeal. In view of the amendments and following remarks, favorable consideration and allowance of the application is respectfully requested.

### **35 U.S.C. §102 Rejections**

Claims 1-3, 9, 12 and 14 stand rejected under 35 U.S.C. §102(b) as being anticipated by Moorehead (US Patent 5,147,332). Applicant traverses this rejection because Moorehead fails to teach all the elements of claim 1, as currently amended.

The Examiner states *inter alia* that Moorehead discloses a catheter having “struts and apertures interspaced around the circumference of a proximal portion of the catheter that extends out of the patient during use.” The Examiner further states that “any portion not at the distal end can be regarded as a proximal portion,” that “proximal and distal portion have not been clearly defined in the specification and/or claims,” and that “Moorehead is fully capable of having a proximal portion of the catheter extending out of the patient during use (figs. 1, 3 and 3A).”

Claim 1 has been amended as follows to require, in part

[[a]] an elongate catheter having a central lumen, a distal portion at one end of the catheter and a proximal portion disposed adjacent an opposite end of the catheter, the proximal portion extending out of the patient during use, the catheter including a plurality of longitudinal struts and longitudinal apertures, the struts and apertures interspaced around the circumference of [[a]] the proximal portion of the catheter that extends out of the patient during use;

Support for this amendment may be found *inter alia* in paragraphs 003, 007, 0020 and 0052, and in Fig. 7. Applicants contend that proximal and distal portions have been clearly defined in the specification and drawings, and in claim 1, as amended. Moorehead fails to teach the above limitations in claim 1. Rather, Moorehead discloses a multi-valve catheter wherein the valves are disposed near the distal end of the catheter such that the valves are disposed entirely within the

patient during use. Applicants concur with the Examiner's contention that "Moorehead is fully capable of having a proximal portion of the catheter extending out of the patient during use," however, Moorehead teaches having valves or struts or slits only at the opposite, distal portion of the catheter that is inside the patient during use:

Present at the distal end 14 of catheter 12 are at least two valves 16 and 18. The opposite, or proximal end 20 of catheter 12 is terminated by a conventional coupling 22 . . . (Moorehead column 6, lines 36-38). Also see Fig. 1.

. . . wall segments 36 flex outwardly in an open position to accommodate fluid discharge through the associated lumen to the body cavity in which distal end 14 of catheter 12 is disposed (emphasis supplied, Moorehead column 8, lines 39-42).

Also see Fig. 3.

. . . wall segments 36 of valve 18 will deflect or flex causing edges 34 to separate at the slit, creating a flowpath-defining orifice through which liquid may pass in or out of lumen 28 when distal end 14 of catheter 12 is indwelling. (emphasis supplied, Moorehead column 8, lines 57-62). Also see Fig. 3A.

Regarding the Examiner's contention that "Moorehead states that the apertures are distances from the distal end of the catheter (abstract)," Applicants respectfully cite the full phrase from Moorehead's abstract:

. . . the plurality of valves are longitudinally separated or offset in their placement at relatively short, but differentiated distances from the distal end of the catheter. .  
(emphasis supplied, Moorehead abstract).

Thus, Moorehead's abstract defines the location of the valves as being at a "relatively short" distance from the distal end. The Examiner has mischaracterized the reference to contend that the abstract teaches the valves being at the proximal end of the catheter.

Any characterization of Moorehead that places valves in a proximal portion of the catheter that extends out of the patient during use would be contrary to the teachings of the reference and would render such an embodiment of Moorehead unusable for its intended purpose. Thus, Moorehead cannot be considered to anticipate claim 1 because nowhere does Moorehead teach all the elements of the claim. Applicant requests that the rejection be withdrawn.

Claims 2-3, 9-12 and 14 depend directly or indirectly from claim 1 and are therefore patentable for at least the reasons described above. Further, the Examiner has failed to point out any parts of Moorehead that are considered to teach the specific limitations of claims 2-3 and 9-12, as required under 37 C.F.R. § 1.104 (c) 2:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (emphasis supplied)

For example, claim 3 recites “the valve of claim 2 wherein a proximal end of the central lumen is sealed proximal to the apertures.” The Examiner has not designated any particular part of Moorehead with respect to claim 3. Moorehead describes an invention “other than that claimed by Applicant,” and does not teach the limitation of claim 3. If Moorehead’s lumen were sealed as required in claim 3, then the catheter could not function as intended. Thus, in at least this example regarding claim 3, the rejections under 35 U.S.C. §102(b) are improper.

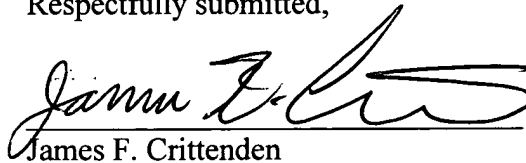
#### Allowable Subject Matter

Applicant gratefully acknowledges the Examiner’s indication that claims 10 and 11 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (978) 739-3075.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "James F. Crittenden", written over a horizontal line.

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